

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEOTAB INC. and TV MANAGEMENT, INC., d/b/a GPS NORTH
AMERICA

Petitioners,

v.

PERDIEMCO LLC,

Patent Owner

Case IPR2016-01063
U.S. Patent 8,717,166

**PATENT OWNER'S PRELIMINARY RESPONSE
PURSUANT TO 35 U.S.C. § 313 AND 37 C.F.R. § 42.107**

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I. INTRODUCTION

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107(a), Patent Owner PerDiemCo LLC (“PerDiem”) respectfully submits this Preliminary Response to the Petition for *Inter Partes* Review (“the Petition”) filed in this matter.¹ Petitioners Geotab Inc. and TV Management, Inc. (collectively “Petitioners”) seek *Inter Partes* Review (“IPR”) of claims 1-13, 18-19, 22-24, and 27 of U.S. Patent No. 8,223,166 (“the ‘166 Patent”), as allegedly being unpatentable under 35 U.S.C. §§ 102(e) and 103(a). The ‘166 Patent is assigned to PerDiem. It was formerly the subject of co-pending litigation, *PerDiemCo, LLC v. Industrack LLC, et al.*, Case No. 2:15-cv-727-JRG-RSP (E.D. Tex.) and *PerDiemCo, LLC v. GPSLogic, LLC et al.*, No. 2:15-cv-16616-JRG-RSP (E.D. Tex.), although PerDiem is not currently pursuing any of the ‘166 claims in those co-pending litigations.

In their Petition, Petitioners assert that various claims of the ‘166 Patent are invalid on two grounds: (1) that the Fast reference² anticipates claims 1-10, 13-16, and 19-25, and (2) that claims 1-10, 13-16, and 19-25

¹ This submission is timely under 35 U.S.C. § 21, as it is being filed within three months following the mailing date of the *Notice of Filing Date Accorded to Petition*.

² U.S. Patent No. 7,327,258 to Fast et al. Fast is attached as Ex. 1003 to Petitioners’ Petition.

are obvious over the combination of Fast and a secondary reference, Zou.³
(Petition at 5). As set forth below, the Petition is unpersuasive on numerous grounds and no IPR should be instituted.

II. INTRODUCTION TO THE '166 PATENT AND SUMMARY OF PETITION DEFICIENCIES

This IPR should not be instituted because Petitioners' invalidity arguments are *wrongly* premised on (1) servers *manually* monitoring event thresholds for moving objects, and (2) specified event condition data that have file names stored in databases somehow monitoring locations. This IPR should also not be instituted because (3) Fast does not teach the claimed requirement of independent administrative privileges for conveying location related information to user groups, and (4) Petitioners adopt the incorrect premise that Fast teaches sending object location messages to independent user groups based on user-specified access privileges, when in fact the sent messages cannot contain object location information.

The '166 Patent describes a centralized system (Ex. 1001⁴ at 12:63-13:2, FIG. 1) that conveys location-related information in a plurality of

³ U.S. Patent Pub. No. US 2005/0156715 to Zou . Zou is attached as Ex. 1005 to Petitioners' Petition.

⁴ The '166 Patent is Ex. 1001 to Petitioners' Petition.

independent user groups (Limitations 1(a) and 1(f)). One or more computing devices configure a plurality of information sharing environments (ISEs) for users based on varying levels of administrative privilege (Limitation 1(b)). The computing devices configure a first information sharing environment (ISE) based on a first level of administrative privilege to associate users with each one of the plurality of user groups (Limitation 1(e)). The computing devices convey location-related information of mobile devices based on location information access privileges associated with authorized users in the user groups (Limitation 1(g)). The claims therefore enable one authorized user conveying event or location information to specific user groups independent of other authorized users and independent of administrators and users having higher/administrative privileges.

The Fast reference conveys object location information to many different users of Fast's system such as operators, supervisors, rescue personnel and the like who have successfully logged into the system simultaneously. (Fast at 14:46-55). Inherent in Fast is that "operators-in-the-loop" are added to the list of users notified about event information.

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